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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,805	05/16/2001	Motoki Nakade	SON-2106	1551

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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,805

Applicant(s)

NAKADE, MOTOKI

Examiner

Cheryl Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the applicant's communication, Amendment A, received on April 5, 2004, paper no. 6.
2. Claims 1-59 are presented for examination.
3. The applicant has amended claims 1-59.
4. Applicant's arguments with respect to claims 1-59 have been considered but they are not deemed to be persuasive.

Response to Arguments

5. a. On page 36, lines 23-25, page 37, lines 3-8 of the applicant's arguments, the applicant states the following:

"In view of this response, that distinction is blurred because the Applicant's system is an online shopping system have features and characteristics not taught or suggested by Dulaney.....Serendipetously, some features of the Applicant's claimed invention as filed and Dulany may have been considered to be closely parallel, but it is recognized that the sales referred to in Dulaney have to do with optimization of inventory, not to an online shopping system. Accordingly, each of the claims of the subject application are amended, at a minimum, to recite an online shopping system item combination presenting apparatus or method."

- a1. The examiner acknowledges the amendments to claims 1-59. The applicant has amended claims 1-59 to overcome the Dulaney reference (6,341,269 B1). In fact, the applicant has agreed, in part that Dulaney's reference is considered to be closely parallel to the claimed invention of the applicant. The applicant's amended claims

currently recite "online shopping" within the applicant's preamble to the claims, as well as "wherein the item is provided from a supplier terminal device". Applicant's arguments are solely based on the amendment to the claims. The applicant has not argued the merits of the Dulaney reference as it has been recited in the prior Office Action mailed January 5, 2004, paper no. 5.

b. On page 37, lines 9-14 of the applicant's arguments, the applicant states the following:

"In addition, in sharp contrast, the Applicant's invention features a capability for an interactive user to arrange items of only shopping in the display and determine the item. Accordingly, the pending claims are amended in various ways to limit the claims to online shopping (by amendment to the preamble of each pending claim) to distinguish over Dulaney, and to variously mention that "a supplier terminal device" in certain claims may be a source of the items."

b1. The applicant is correct, Dulaney is directed to optimization of inventory and merchandising including store-level point-of-sale (a.k.a., POS) data. The examiner has changed the pending 102 rejection of Dulaney cited in the Office Action January 5, 2004, paper no. 5 to a 103 rejection including Dulaney and Robertson (6,609,106 B1). The examiner has currently cited Robertson to teach the applicant's amended claim limitations including "online shopping" and "wherein the item is provided from a supplier terminal device". Robertson teaches online shopping, see Abstract, lines 1-14. Also, Robertson teaches "wherein the item is provided from a supplier terminal device". Robertson states that each SP site will typically comprise one or more physical servers that are connected to the Internet. Each SP site runs at least one server application for providing an online service (see col. 11, lines 24-65, col. 12, lines 25-65). Also, the

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Dulaney reference has been cited in the prior Office Action for teaching a user interactive arrangement of items. This claim limitation is presented in the Office Action below. Again, the applicant has not argued the merits of the Dulaney reference and how the Dulaney reference differs from the applicant's claimed limitations. The applicant's arguments only address the claims as presently amended.

The remaining claims each comprise claim limitations corresponding substantially to the above-discussed claim limitations and are also addressed by the above remarks.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dulaney et al. (Pat. No. 6,341,269 B1, filed December 30, 1999, hereinafter Dulaney) and Robertson (Pat. No. 6,609,106 B1 filed May 7, 1999).

8. Regarding Claims 1, 5, 29, and 33, Dulaney teaches a system, method and article of manufacture to optimize inventory and merchandising shelf space utilization.

The method and associated system for manufacture to optimize inventory and merchandising shelf space utilization as taught or suggested by Dulaney includes:

accumulating means for accumulating plural pieces of information corresponding to information on items (figure 1, elements 1.1-1.14, col. 4, lines 12-65), plural pieces of item attribute information (col. 7, lines 25-67, '*Item identifier, UPC Code for the item, SKU description or name...*', col. 8, lines 1-67) corresponding to attribute information including selection standards (col. 9, lines 1-41, col. 10, lines 42-66) of the item information (figure 1, elements 1.1-1.14, col. 4, lines 12-65), plural pieces of space information (Abstract, lines 1-7 and 17-22, col. 4, lines 29-41 and 66-67, col. 5, lines 1-20) corresponding to information representing a space in which items are arranged (col. 6, lines 14-33, col. 9, lines 66-67, col. 10, lines 1-10), and plural pieces of space

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attribute information corresponding to attribute information representing selection standards of the space information (col. 11, lines 23-67); searching means for searching, in response to a request for specifying space attribute information (col. 9, lines 24-67, col. 10, lines 1-10), space information having space attribute information thus specified and item information having the same item attribute information (col. 15, lines 52-67, col. 16, lines 1-15) as the space attribute information (col. 15, lines 52-67, col. 16, lines 1-15) from the space information and the item information accumulated (figure 1, elements 1.1-1.14, col. 4, lines 12-65); calculating means for calculating (figure 1A, *'Increment Facings...Calculate IHC & LSC for this Number of Facings Calculate Space...Calculate IHC and LSC for Current Facings...Calculate Current Space Requirements'*), on the basis of the item information and space information searched (col. 9, lines 24-67, col. 10, lines 1-10, col. 11, lines 41-67), item combination arrangement information representing the arrangement of the item information in the space information (col. 6, lines 14-33, col. 9, lines 66-67, col. 10, lines 1-10); transmitting the item combination arrangement information (Abstract, lines 1-22); and a terminal device for input information (Abstract, lines 8 and 9); adding item selling information corresponding to the item information (col. 17, lines 10-35).

However, Dulaney does not expressly teach the terminal device accesses the supplier terminal device supplying the item information and record purchase information.

Robertson teaches the terminal device accesses the supplier terminal device supplying the item information (col. 9, lines 45-67, col. 11, lines 24-57, col. 12, lines 26-67) and record purchase information (col. 12, lines 34-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the merchandising data of Dulaney's method with the merchandising data of Robertson's method because Robertson's method enables a service provider to maintain a list of items of interest on behalf of a user and allows the user to either purchase items or have items transferred to an online gift registry web site, the online gift registry web site provides an online service for the registration of information for a gift registrant and allows access to the registry by potential gift giver users (see Robertson, col. 10, lines 5-35).

9. Regarding Claims 2, 6, 11, 16, 21, 30, 34, 39, 44, 49, and 55, the limitations of these claims have been noted in the rejection above. In addition, Dulaney teaches purchase information of items for an item record (col. 10, lines 60-67, col. 11, lines 1-39).

10. Regarding Claims 3, 7, 12, 17, 26, 31, 35, 40, 45, 50, 56, and 59, Dulaney teaches item record information having purchase information frequently recorded (col. 10, lines 11-27).

11. Regarding Claims 4, 8, 13, 18, 22, 27, 32, 36, 41, 46, 51, and 57, Dulaney teaches the regulated space means (col. 9, lines 63-67, col. 10, lines 1-10).

12. Regarding Claims 9, 14, 19, 24, 37, 42, 47, and 53, Dulaney teaches an item combination presenting device for presenting to a terminal device an item combination

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proposal (Abstract, lines 1-22, col. 1, lines 10-35), transmitting means for transmitting item information corresponding to information on items the combination of which the item combination presenting device presents (Abstract, lines 1-22), and item attribute information (col. 7, lines 25-67, '*Item identifier, UPC Code for the item, SKU description or name...*', col. 8, lines 1-67) corresponding to attribute information representing selection standards of the item information (figure 1, elements 1.1-1.14, col. 4, lines 12-65); item combination includes first reception means (Abstract, lines 1-27) for receiving the item information and the item attribute information (col. 9, lines 1-41, col. 10, lines 42-66), accumulating means for accumulating plural pieces of item information and item attribute information received by the first reception means (figure 1, elements 1.1-1.14, col. 4, lines 12-65), plural pieces of space information corresponding to information representing a space in which items are arranged (Abstract, lines 1-7 and 17-22, col. 4, lines 29-41 and 66-67, col. 5, lines 1-20), plural pieces of space attribute information corresponding to attribute information representing selection standards of space information (Abstract, lines 1-7 and 17-22, col. 4, lines 29-41 and 66-67, col. 5, lines 1-20, col. 9, lines 1-41, col. 10, lines 42-66), searching means in response to a request for specifying space attribute information (col. 9, lines 24-67, col. 10, lines 1-10), space having space attribute information thus specified and item information having the same item attribute information as the space attribute information from the space information and the item information (Abstract, lines 1-7 and 17-22, col. 4, lines 29-41 and 66-67, col. 5, lines 1-20, col. 9, lines 1-41, col. 10, lines 42-66), calculating means on the basis of the item information and the space information (figure 1A, '*Increment*

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Facings...Calculate IHC & LSC for this Number of Facings Calculate Space...Calculate IHC and LSC for Current Facings...Calculate Current Space Requirements'), second reception means for receiving item combination information transmitted from second transmitting means (Abstract, lines 1-27, and displaying the item combination information (col. 10, lines 43-67).

13. Regarding Claim 10, 15, 20, 25, 38, 43, 48, and 54, the limitations of this claim has been noted in the rejection above. In addition, Dulaney teaches the apparatus adds the item combination arrangement information thus calculated with item selling information for selling the item (col. 11, lines 23-67).

14. Regarding Claims 23, 28, 52, and 58, the limitations of these claims have been noted in the rejection above. In addition, Dulaney teaches determining a prioritized order of items (col. 7, lines 5-17, col. 11, lines 3-38) and items of a time based (Abstract, lines 18-19, col. 5, lines 23 and 37).

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

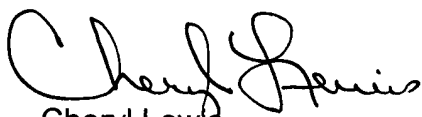
NAME OF CONTACT


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (703) 305-8750. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

(703) 746-5651 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Cheryl Lewis
Patent Examiner
June 25, 2004


CHETA ROBINSON
PRIMARY EXAMINER